

REMARKS / ARGUMENTS**I. General Remarks**

Claims 1-37 are pending. Claims 1, 7-12, 16, 18, 19, 20-23, 25, 27, and 29-33 have been amended. Applicants thank Examiner for her careful consideration of this application.

II. Remarks Regarding the Double Patenting Rejection

Claims 1, 6, 16, 17, 27, and 28 stand provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 12, 66-68, 70, and 82-84 of copending patent application 10/607,011 to Nguyen *et al.* in view the teachings of U.S. Patent No. 6,387,986 to Moradi-Araghi *et al.*

Applicants enclose the timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c). The patent application 10/607,011 and the present application are both commonly owned by assignee Halliburton Energy Services, Inc. Thus, this rejection is respectfully traversed. In filing this terminal disclaimer, Applicants note, however, in accordance with the M.P.E.P. and Federal Circuit case law, that the “the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption nor estoppel on the merits of the rejection.” *See* M.P.E.P. § 804.02 (citing *Quad Envtl. Tech. Corp. v. Union Sanitary Dist.*, 946 F.2d 870, 874 (Fed. Cir. 1991)).

III. Remarks Regarding the 35 U.S.C. § 103 Rejections**A. Statement of Common Ownership Removing the Nguyen Reference as Prior Art Under § 103(a)**

Claims 1, 6-11, 15-22, 26-33, and 37 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Publication No. 2004/0261994 issued to Nguyen *et al.* in view of U.S. Patent No. 6,387,986 to Moradi-Araghi *et al.*

The present application and U.S. Patent No. 6,626,241 issued to Nguyen *et al.* were, at the time the invention of present application was made, both owned by Halliburton Energy Services, Inc. As the present application was filed on or after November 29, 1999, a statement of common ownership, at the time the invention of the present application was made, is sufficient to remove prior art from the purview of 35 U.S.C. § 103(a) if that prior art would have been prior art only under 35 U.S.C. § 102(e). M.P.E.P. § 706.02(I). Accordingly, U.S. Patent No. 6,626,241 is no longer available as prior art under 103(a) in accordance with 35

U.S.C. § 103(c). Thus, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejection against claims 1, 6-11, 15-22, 26-33, and 37 is no longer applicable, and this rejection should be withdrawn.

B. *Miller* in view of *Moradi-Araghi*

Claims 1, 6, 15-17, 26-28, and 37 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 3,099,318 issued to Miller *et al.* [hereinafter "*Miller*"] in view of U.S. Patent No. 6,387,986 issued to Moradi-Araghi *et al.* [hereinafter "*Moradi-Araghi*"].

A prima facie case of obviousness requires a suggestion or motivation in the prior art references to make the specific combination of elements claimed by Applicants. M.P.E.P. § 2143.01 (citing *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held *improper*.); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.)). The cited prior art references contain no such motivation or suggestion to combine the elements of *Miller* and *Moradi-Araghi* to arrive at the specific combination of elements claimed by Applicants.

Generally, *Miller* is directed to sand control and mitigating fines migration by use of a screening element. *See Miller*, col. 1, lines 14-36. The degradable materials of *Miller* are directed to acting as a temporary constrictive member around the screening element. *See Miller*, col. 4, lines 25-75 and col. 5 lines 1-44. Unlike *Miller*, the degradable materials of *Moradi-Araghi* are directed to encapsulating crosslinking agents with a degradable material so as to delay the onset of a crosslinking gel. *See Moradi-Araghi*, Summary of Invention Section. Thus, the degradable materials of *Moradi-Araghi* are not directed to acting as a constrictive member around a screening element and is in fact directed to a different purpose entirely. Consequently, a person of ordinary skill in the art would not have been motivated to combine the teachings of *Miller* and *Moradi-Araghi* to arrive at the specific combination of elements claimed by Applicants.

The Examiner writes as follows:

As it would be advantageous to have the wrap made of a polymer that is degradable downhole, it would be obvious to modify the degradable wrap disclosed by *Miller* to be made of poly(orthoester) as taught by *Moradi-Araghi*.

See Final Office Action at 6-7. Applicants respectfully submit that the Examiner has not pointed to any suggestion or motivation to combine the teachings of *Miller* and *Moradi-Araghi* that is present in the cited references themselves. The Examiner has provided no evidence or finding of the specific understanding or principle within the knowledge of a person of ordinary skill in the art at the time of the invention that would have supplied the motivation to modify *Miller* so as to include poly(orthoesters) of *Moradi-Araghi*. *See* M.P.E.P. § 2143.01.

As provided in M.P.E.P. § 2144.03(C), a conclusion as to the supposed action of a person of ordinary skill in the art is insufficient to establish a *prima facie* case of obviousness. To the extent that Examiner relies on such a statement or statements to supply the necessary motivation to combine or modify the prior art references, Applicants hereby respectfully traverse the lack of such a showing and request under M.P.E.P. § 2144.03(C) that the Examiner supply an affidavit or other documentary proof establishing the prior art knowledge that would have motivated a person of ordinary skill in the art to make the specific modification and/or combination of elements to arrive at Applicants' invention.

Additionally, Applicants respectfully point out that the Federal Circuit has made clear that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680,682 (Fed. Cir. 1990)). The M.P.E.P. also makes clear the requirement that the Examiner provide objective reasons to combine the references apart from naked statements that "it would be obvious to a person of ordinary skill." M.P.E.P. § 2143.01 (explaining that "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." (citations omitted)).

Thus, Applicants respectfully submit that combining *Miller* and *Moradi-Araghi* is an inappropriate combination of references. Further, the references contain no suggestion or motivation to combine or to modify the references to arrive at the specific combination of elements of the present invention. Thus, Applicants respectfully request the removal of the 35

U.S.C. § 103(a) rejection as to the independent claims 1, 16, and 27, and correspondingly, dependent claims 6, 15, 17, 26, 28, and 37.

C. *Miller in view of Moradi-Araghi and further in view of Wehunt*

Claims 2-5 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. U.S. Patent No. 3,099,318 issued to Miller *et al.* [hereinafter “Miller”] in view of U.S. Patent 5,507,345 issued to Wehunt *et al.* [hereinafter “Wehunt”].

Examiner’s arguments with respect to claims 2-5 are moot in light of the discussion above in section III.C., showing that the 35 U.S.C. § 103(a) rejection as to independent claim 1 should be withdrawn. As claims 2-5 depend, either directly or indirectly from independent claim 1, Applicants respectfully request removal of the 35 U.S.C. § 103(a) rejection as to dependent claims 2-5.

D. *Miller in view of Moradi-Araghi and further in view of Voll*

Claims 7-9, 18-20, and 29-31 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. U.S. Patent No. 3,099,318 issued to Miller *et al.* [hereinafter “Miller”] in view of U.S. Patent 5,507,345 issued to Voll *et al.* [hereinafter “Voll”]. Applicants assume that the reference to “Miller ‘818 Patent” in the office action is intended to refer to the Miller ‘318 Patent.

Examiner’s arguments with respect to claims 7-9, 18-20, and 29-31 are moot in light of the discussion above in section III.C., showing that the 35 U.S.C. § 103(a) rejection as to claims 1, 16, and 27 should be withdrawn. As dependent claims 7-9, 18-20, and 29-31 depend, either directly or indirectly from independent claim 1, Applicants respectfully request removal of the 35 U.S.C. § 103(a) rejection as to dependent claims 7-9, 18-20, and 29-31.

E. *Miller in view of Moradi-Araghi and further in view of Sinclair*

Claims 10-14, 21-25, and 32-36 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. U.S. Patent No. 3,099,318 issued to Miller *et al.* [hereinafter “Miller”] in view of U.S. Patent 5,507,345 issued to Sinclair *et al.* [hereinafter “Sinclair”]. Applicants assume that the reference to Miller ‘818 Patent in the office action is intended to refer to the Miller ‘318 Patent.

Examiner’s arguments with respect to claims 10-14, 21-25, and 32-36 are moot in light of the discussion above in section III.C., showing that the 35 U.S.C. § 103(a) rejection as to independent claims 1, 16, and 27 should be withdrawn. As claims 10-14, 21-25, and 32-36

depend, either directly or indirectly from independent claims 1, 16, and 27, Applicants respectfully request removal of the 35 U.S.C. § 103(a) rejection as to dependent claims 10-14, 21-25, and 32-36.

SUMMARY

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that no fees are due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for extensions of time, the Commissioner is authorized to debit Baker Botts L.L.P. Deposit Account No. 02-0383, (*formerly Baker & Botts, L.L.P.*), Order Number 063718.0284, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,
BAKER BOTTS L.L.P.

By: 

Carey Jordan
Registration No. 47,646
Baker Botts L.L.P.
One Shell Plaza
910 Louisiana
Houston, TX 77002
Telephone: 713.229.1233
Facsimile: 713.229.7833
ATTORNEY FOR APPLICANTS

Date: August 30, 2005